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PROCOPIO, CORY, HARGREAVES & SAVITCH LLP 530 B STREET SUITE 2100 SAN DIEGO, CA 92101			EXAMINER MURDOUGH, JOSHUA A	
			ART UNIT 3621	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/686,955	Applicant(s) SINGER ET AL.	
	Examiner JOSHUA MURDOUGH	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 39 is/are pending in the application.
- 4a) Of the above claim(s) 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/27/2009, 10/21/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

Acknowledgements

1. This action is responsive to Applicants' amendments received 7 August 2009.
2. This action has been assigned paper number 20091217 for reference purposes only.
3. Claims 1-20 and 39 are pending.
4. Claim 39 is withdrawn.
5. Claims 1-20 have been examined.

Claim Objections

6. Claim 1 is objected to because of the following informalities: in lines 16-17 claim 1 recites "said source content and said root license stored are stored on said server." This appears to be a typographical error. Appropriate correction is required.

Drawings

7. The drawings are objected to because Figure 23 shows the "Bound Instance" 2300 as containing the "Server" 2305 and the "Client" 2350. According to Applicant's specification, an "instance" is a collection of data. See definition of "instance" below. As the client and server are not understood to be data, this figure does not make sense. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from

the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-20 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 1 recites "wherein said discrete content and the discrete license are stored on said server." Furthermore, claim 1 recites "a single server and one or more clients as member of said hub network." Therefore, the server and the one or more clients are internal to the hub network. Because the discrete license is stored on the server, it is also internal to the hub network. The definition provided by Applicants for "bound" is "internal to the hub network." See definition below. Therefore, according to the definition, the discrete license is bound to the hub network. However, Claim 1 also recites "wherein the discrete license in not bound to said hub network."

Because, by definition the discrete license is bound and according to the claim limitations it is not bound, one of ordinary skill in the art would not understand the metes and bounds of this claim.

11. Claim 1 recites the limitation "said content" in line 13. There is insufficient antecedent basis for this limitation in the claim. Previous to this recitation of "said content" both "a discrete instance of content" (line 3) and "discrete locked content" (line 5). Because of the two distinct occurrences of content, one of ordinary skill in the art would not know which content is being referred to.

12. Claim 1 further recites "a bound instance" and "a discrete instance." However, there is no relationship established between these instances. Therefore, one of ordinary skill in the art would not understand whether the instances represent modified versions of the same content and associated files, copies of the same content and associated files, or unrelated content and files. Therefore, one of ordinary skill in the art would not understand if the "source locked content data" and "root license" are related to the "discrete locked content data" and the "discrete license." Because the interrelation of the parts is not set forth, one of ordinary skill in the art would not understand the metes and bounds of this claim. The Examiner has reviewed the Specification again. As understood from this review, the discrete instance becomes a bound instance when placed on the server. See definition of "bound" below. The Examiner has used this interpretation when applying the prior art. However, this needs to be shown in the claims in order for them to serve the notice function required of the claims.

13. Claim 6 recites the limitation "said discrete version" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim. Applicant's current amendment removed all

instances of “version” from claim 1. As claim 6 depends only from claim 1 there is no previous mention of “a discrete version.” It is the Examiner’s position that Applicants intended to replace this instance of “version” with “instance” and this interpretation has been used when applying the prior art. However, one of ordinary skill in the art, looking at a clean copy of the claims would not necessarily realize this intent. Therefore, this term needs to be amended to be “instance.”

14. Claim 7 recites the limitation "said source version" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim. As noted above, the word “version” does not appear in claim 1. The Examiner finds two possible interpretations for what "said source version" refers to. First, it could refer to "source locked content data." Second, it could refer to the “bound instance.” Because these two interpretations result in different understandings of the claim, one of ordinary skill in the art would not understand the metes and bound of this claim.

15. Claim 8 recites “creating a copy of said discrete locked content data; and storing said copy as said source locked content data.” However, "source locked content data" is part of the "bound instance.” The word “bound” is defined by Applicants to mean “internal to the hub network.” Therefore, it appears that once the “discrete locked content data” is stored on the server (as recited in claim 1) it becomes bound. As it is bound, one of ordinary skill in the art would understand it to be part of a bound instance and therefore, "source locked content data.” Thus, it is unclear how the discrete locked content data is copied to make source locked content data.

16. Claim 8 also recites “storing said copy as said source locked content data.” This makes it unclear to one of ordinary skill in the art whether the copy becomes source locked content data or if it is merely treated as source locked content data.

17. Claim 9 recites the limitation "according to discrete licensing authority data" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim. Because “discrete licensing authority data” is not previously mentioned, one of ordinary skill in the art would not understand what is needed to create data “according to discrete licensing authority data.”

18. Claim 9 recites the limitation "said discrete version" in line 4. There is insufficient antecedent basis for this limitation in the claim. It is again the Examiner’s position that Applicants intended to replace this instance of “version” with “instance” and this interpretation has been used when applying the prior art. However, one of ordinary skill in the art, looking at a clean copy of the claims would not necessarily realize this intent. Therefore, this term needs to be amended to be “instance.”

19. Claim 9 recites the limitation "said source version" in line 6. There is insufficient antecedent basis for this limitation in the claim. As noted above, the word “version” does not appear in claim 1. The Examiner finds two possible interpretations for what "said source version" refers to. First, it could refer to "source locked content data." Second, it could refer to the “bound instance.” Because these two interpretations result in different understandings of the claim, one of ordinary skill in the art would not understand the metes and bound of this claim.

20. The Examiner finds that because particular claims are rejected as being indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time.

However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied as much as practically possible.

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 1-20, as understood by the Examiner, rejected under 35 U.S.C. 103(a) as being unpatentable over Mourad (US 2003/0135464).

23. As to claims 1, 3, 8 and 10, Mourad shows:

- a. A method of binding content to a hub network, comprising:
- b. receiving a request to bind a discrete instance of content to a hub network including a single server **111** and one or more clients **109** as members of said hub network (Figure 1D),
- c. wherein said discrete version instance includes discrete locked content data **148** and a discrete license associated with the discrete locked content data **147**,
- d. wherein said discrete content data and the discrete license are stored on said server (see rejection under 112 2nd above);,
- e. wherein the discrete license is not bound to said hub network (see rejection under 112 2nd above);

- f. disabling said discrete instance (“disable the content” [0957]);
 - g. enabling a bound instance to bind said content to said hub network at the server “enable it to make this Content 113 available for download to its customers,” [0858]),
 - h. wherein said bound instance includes source locked content data 196 and a root license associated with the source locked content data 197;
 - i. wherein said root license is bound to said hub network (109 is part of the network, therefore, the license is internal to the hub network when it is on the user device. Figure 1D).
24. Maurad does not expressly show:
- j. wherein said source content data and said root license stored are stored on said server, and
25. However, this is merely a rearrangement of parts. Moving data from one computer to another (client to server) would be well within the abilities of one of ordinary skill in the art. Essentially, the storage of the server (content hosting site) would replace the storage of the client (end user device). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Mourad to store the bound instance on the server’s storage instead of on the client’s storage because both storages were clearly known and one of ordinary skill in the art would know how to save to the server instead of the client.
26. As to claim 2, Mourad further shows:
- k. receiving said discrete instance stored on compliant media **302**;

- l. wherein compliant media is readable and writable electronic storage media (inherent for the storage to have use in this manner).
27. As to claim 4, Mourad further shows:
 - m. disabling said discrete instance includes disabling said discrete license (if the content cannot be used, the license governing the usage cannot be used either).
28. As to claim 5, Mourad further shows:
 - n. enabling a bound instance creating said root license includes creating said root license according to said discrete license (it cannot be enabled unless it is created).
29. As to claim 6, Mourad further shows:
 - o. said server will decrypt said discrete locked content data after disabling said discrete version upon request (No step is being claimed in a positive manner. Reciting that something will happen, does not mean it has to happen for anticipation/infringement.).
30. As to claim 7, Mourad further shows:
 - p. said root license indicates said server has root responsibility for said source version ("content owner," [0316]).

31. As to claim 9, Mourad further shows:

q. creating bound licensing authority data according to discrete licensing authority data (making data internal to the hub network does not alter the data);

r. wherein said discrete licensing authority data corresponds to said discrete version and said discrete licensing authority data indicates an external server is an external licensing authority, said bound licensing authority data corresponds to said source version and said bound licensing authority data indicates said root license is a local licensing authority and said external server is an external licensing authority (making data internal to the hub network does not alter the data).

32. As to claim 11, Mourad further shows:

s. checking whether said server is in said revocation list before disabling said discrete instance and enabling said bound instance [0434].

33. As to claim 12, Mourad further shows:

t. updating a server revocation list stored by said server according to said revocation list of said discrete instance [0434]; and

u. checking whether said server is in said server revocation list before disabling said discrete instance and enabling said bound instance (Id.).

34. As to claim 13, Mourad further shows:

v. creating a revocation list corresponding to said bound instance by creating a copy of said revocation list corresponding to said discrete instance [0434].

35. As to claim 14, Mourad further shows:

w. said server and said one or more clients are compliant devices, a compliant device will not decrypt locked content data without a license that is bound to a hub network of which the compliant device is a member (All actions are controlled by the license, if the license is not present, thus not bound, the content cannot be used.).

36. As to claim 15, Mourad further shows:

x. a compliant device that is not a member of said hub network will only decrypt said discrete locked content data upon request while said discrete instance is not disabled (if it is disabled, no device should be able to decrypt it).

37. As to claim 16, Mourad further shows:

y. creating a source key by copying a discrete key (the keys are released (copies are sent) for authorized and appropriate usage requests. [0169]);
wherein said discrete key is for decrypting said discrete locked content data, and said source key is for decrypting said source locked content data (they are copies of each other).

38. As to claim 17, Mourad further shows:

z. said discrete locked content data is encrypted using a content encryption technique (“using a first encrypting key” [0020]), said source locked content data is encrypted using said content encryption technique (this is a copy of the discrete key and data), said discrete key is encrypted using a hub network encryption technique that is different from said content encryption technique (“the content is encrypted with a symmetric key” and “the symmetric key is encrypted using the public key” [0318]), and said source key is encrypted using said hub network encryption technique (the key is a copy of the discrete key).

39. As to claim 18, Mourad further shows:

aa. said server stores a hub network key **621** for decrypting data encrypted using said hub network encryption technique [0318].

40. As to claim 19, Mourad further shows:

bb. said hub network encryption technique is different from said content encryption technique because said hub network encryption technique uses a different key for encrypting data than the key that said content encryption technique uses for encrypting data (“the content is encrypted with a symmetric key” and “the symmetric key is encrypted using the public key” [0318]).

41. As to claim 20, Mourad shows as set forth in regards to claim 17, but does not expressly show:

cc. said root license is encrypted using said hub network encryption technique.

42. However, as Mourad shows encryption with a public key (hub network encryption technique) [0318] and a bound license **197**, the limitation not expressly shown requires the application of a known process to known data. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified the teachings of Mourad to encrypt the bound license with the public key because this would secure the license and would perform in a predictable manner.

Response to Arguments

43. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Claim Interpretation

44. The Examiner hereby points to the following lexicographic definitions set forth in Applicants' Specification. MPEP § 2106 II. (C) states "Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim." Because Applicants have lexicographically defined these terms and phrases, these lexicographic definitions must be used to interpret the claims:

dd. ***Bound***: "internal to the hub network." Specification, Page 15, Line 14.

ee. **Content:** “[T]he audio and/or video of an item of media, such as a movie or song.

One item of content is one particular item of media, such as one movie.” Specification, Page 4, Lines 21-22.

ff. **Content data:** “the data representing an item of content.” Specification, Page 4, Lines 22-23.

gg. **Discrete:** “external to the hub network.” Specification, Page 15, Lines 13-14.

hh. **Instance:** “a logical collection of data including the content data for an item of content.” Specification, Page 4, Lines 23-24

ii. **License:** “the data storing the permissions for using content data, such as whether content data is permitted to be played or copied by a device.” Specification, Page 4, Lines 29-31.

jj. **Play:** “rendering and displaying the content data of an instance of content or otherwise presenting the content data according to the type of content (e.g. presenting audio and video for a movie or presenting audio for a song).” Specification, Page 4, Lines 25-28.

kk. **Present:** “rendering and displaying the content data of an instance of content or otherwise presenting the content data according to the type of content (e.g. presenting audio and video for a movie or presenting audio for a song).” Specification, Page 4, Lines 25-28.

ll. **Presenting an instance:** “rendering and displaying the content data of an instance.” Specification, Page 4, Lines 28-29.

45. According to these definitions, the Examiner interprets the following phrases as detailed below:

mm. ***Bound Instance***: “a logical collection of data including the content data for an item of content which is internal to the hub network.”

nn. ***Discrete Instance***: “a logical collection of data including the content data for an item of content which is external to the hub network.”

46. The Examiner notes that claims 1-20 are method claims.

47. However, many of the limitations presented are not method steps. For example, claim 3 recites “said discrete instance has a corresponding discrete license.” This limitation has no function. Moreover, the discrete license is already part of the discrete instance recited in claim 1.

48. Similarly, claim 10 recites “said discrete instance has a corresponding revocation list of one or more revoked devices, wherein a revoked device is a device with an authorization to participate in a hub network that has been revoked.” This is merely defining the data present and its arrangement. There is no use of the data recited in this claim.

49. The Examiner points to the above limitations as exemplary. A review of all claim limitations and MPEP §§ 2106 II (C) and 2106.01 is suggested to ensure the limitations receive the desired weight.

50. To be clear, the Examiner has considered all of the limitations presented in claims 1-20. There is nothing inherently “wrong” with reciting limitations directed towards descriptive material or other elements that do not alter the method, which should be evidenced by the lack of

a rejection (112) or objection to these limitations. However, some of the limitations have been considered not to alter the performed method and therefore have been given less weight.

Conclusion

51. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

52. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

53. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The Examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

54. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

55. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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